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In re Application of	:	
GUEST et al.	:	
U.S. Application No.: 10/539,461	:	
PCT No.: PCT/IB03/05665	:	DECISION ON PETITION
Int. Filing Date: 22 December 2003	:	UNDER 37 CFR 1.47(b)
Priority Date: 20 December 2002	:	
Attorney Docket No.: 033327.0024	:	
For: PAYMENT SYSTEM	:	

This decision is issued in response to applicant's Petition under 37 CFR 1.47(b) filed 30 May 2006 to accept the application without the signature of the joint-inventors, John Guest and Brian Tagg. The \$200 petition fee has been submitted.

BACKGROUND

On 22 December 2003, applicant filed international application PCT/IB03/05665 which claimed a priority date of 20 December 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 June 2005.

On 20 June 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 31 October 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 30 May 2006, applicant filed the present petition under 37 CFR 1.47(b) and five-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1); (3); (4); and (6). However, items (2) and (5) have not been satisfied.

Regarding item (2) above, petitioner states that John Guest and Brian Tagg cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), Proof of Unavailability or Refusal, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted.

Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

a. **Inventor John Guest**

A review of the present petition reveals that applicant has not provided an acceptable showing that a diligent effort was made to reach the non-signing inventor, John

Guest. Denise Taliaferro states that John Guest cannot be found after diligent effort. However, no documentary evidence has been presented that indicates John Guest cannot be found or located. Further, the single mailing of the papers to the nonsigning inventor's last known address does not constitute a "diligent" effort to locate the inventor. Applicant must show that alternative means were employed, such as a search of telephone and/or Internet directories, in an attempt to locate John Guest. As stated above, copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration.

b. Inventor Brian Tagg

A review of the present petition reveals that applicant has not provided an acceptable showing that a diligent effort was made to reach the non-signing inventors, Brian Tagg. Denise Taliaferro states that Brian Tagg cannot be found after diligent effort. Petitioner has provided a copy of a cover letter and an "UPS Authorization Form" which indicates that "the consignee moved from address, therefore, shipment (is) undeliverable." However, petitioner fails to include evidence of any other attempts made to locate the nonsigning inventor. The single mailing of the papers to the nonsigning inventor's last known address does not constitute a "diligent" effort to locate the inventor. Applicant must show that alternative means were employed, such as a search of telephone and/or Internet directories, in an attempt to locate Brian Tagg. As stated above, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied by a person having firsthand knowledge of the facts.

Concerning item (5), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. MPEP 409.03(f).

Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

The present petition states that the inventors John Guest and Brian Tagg assigned the invention to Inca Payments Ltd. ("Inca") and that Inca subsequently assigned the invention to GTECH Global Services Corporation Ltd. ("GTECH"). Petitioner has provided an "IP Assignment Agreement" executed by John Guest and Brian Tagg but it is unclear whether the assignment is directed to the instant application or solely to United Kingdom application no. 0229765.3. Further, petitioner has not provided documentary evidence of a "chain of title" from Inca to GTECH.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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